



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,545	08/09/2001	Peter Schlemm	A-2812	6082
24131	7590	11/08/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			GUTIERREZ, ANTHONY	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/927,545	<b>Applicant(s)</b> PETER SCHLEMM	
	<b>Examiner</b> Anthony Gutierrez	<b>Art Unit</b> 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4 and 13 are objected to because of the following informalities:

Claim 4 recites, "wherein method steps are stored in a storage device".

Claim 13 recites "A storage device storing the method steps".

These claims recite language that does not seem to sufficiently connect conceptual ideas, such as "method steps" with a physical apparatus, such as a "storage device".

Examples of the type of language the Examiner feels would properly convey what he believes is the Applicant's intended meaning is "wherein method steps are codified into a storage device" or "wherein method steps are stored as code in a storage device".

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al. (US Patent 5,764,900).

As to claim 1, Morris et al. discloses a method of executing method steps, which comprises: checking whether an output mode is switched on; and producing an

output signal in a method step and outputting the output signal only if the output mode is switched on (col. 6, lines 34-51).

As to claim 2, Morris et al. further discloses wherein the method steps are divided into modules, and the method comprises changing from one module to another module during the execution of the method steps, and wherein the output signal comprises an identifier indicating in which module the output signal was produced (col. 1, lines 50-65).

As to claim 3, Morris et al. further discloses executing the method steps in a plurality of devices, and generating the output signal with an identifier indicating the device in which the output signal was produced (col. 1, lines 50-65).

As to claim 4, Morris et al. further discloses wherein the method steps are stored in a storage device, and the method comprises reading out the method steps from the storage device and executing the method steps, and wherein the output signal comprises an identifier indicating where the method step is stored that produced the output signal (col. 3, lines 29-53).

As to claim 5, Morris et al. further discloses wherein the output signal comprises an identifier indicating in which method step the output signal was produced (col. 7, lines 6-41 and Fig. 7).

As to claim 6, Morris et al. further discloses wherein the output mode is one of a plurality of output modes, and the method comprises checking which output mode is set, and wherein the output signal comprises an identifier indicating to which output mode the output signal belongs, and wherein only the output signals belonging to the set output mode are outputted (col. 7, lines 6-41 and Fig. 7).

As to claim 7, Morris et al. further discloses outputting the output signal via an output unit as a signal selected from the group consisting of optical and acoustic signals (col. 4, lines 16-22, Title, Abstract).

As to claim 8, Morris et al. further discloses wherein the output signal is stored in a storage device, together with an indication of a time at which the output signal was stored (col. 3, lines 14-21).

As to claim 9, Morris et al. discloses a device for executing method steps, which comprises a control apparatus producing an output signal, said control apparatus being configured to check whether an output mode is switched on, and to output the output signal if the output mode is switched on (col. 6, lines 34-51).

As to claim 10, Morris et al. further discloses wherein said control apparatus is a first control apparatus and comprising a second control apparatus, and wherein one of said first and second control apparatus produces the output signal, and said first or second control apparatus outputs the output signal if an output mode is switched on, and the output signal comprises an identifier indicating whether the output signal was produced by said first or second control apparatus (col. 1, line 66- col. 2, line 8 and col. 6, lines 34-51).

As to claim 11, Morris et al. further discloses wherein the output signal includes an identifier indicating at which method step the output signal was produced (col. 7, lines 6-41 and Fig. 7).

As to claim 12, Morris et al. further discloses wherein at least one of said first and second control apparatus executes method steps in the form of program modules, and

the output signal comprises an identifier indicating the module in which the output signal was produced (col. 7, lines 6-41 and Fig. 7).

As to claim 13, Morris et al. further discloses a storage device storing the method steps; and wherein at least one of said first and second control apparatus is configured to read out the method steps for the execution from the storage device; and wherein the output signal comprises an identifier indicating a location at which the method steps are stored in said storage device (col. 3, lines 29-53).

As to claim 14, Morris et al. further discloses wherein the location is identified in said storage device via a memory address (col. 5, lines 35-45).

As to claim 15, Morris et al. further discloses wherein the location is identified in said storage device via a data filename (col. 5, lines 22-35).

As to claim 16, Morris et al. further discloses input means configured to enable selective switching on and switching off of the output mode even during the execution of the method steps (col. 5, lines 6-17).

### ***Response to Arguments***

4. Applicant's arguments filed 7/30/04 have been fully considered but they are not fully persuasive.

The Examiner has withdrawn the rejection made under 35 USC 112, but has now presently included claim objections with respect to some of the matter originally rejected under 35 USC 112.

The Examiner however presently maintains the basis for his original prior art rejection under 35 USC 102 (b) to Morris et al. (US Patent 5,764,900).

The Applicant has argued that the cited reference does not show claimed subject matter specifically stated in independent claims 1 and 9, therefore suggesting that those and all depending claims are allowable. The specific subject matter is "checking whether an output mode is switched on; and producing an output signal in a method step and outputting the output signal only if the output mode is switched on".

The Examiner disagrees with the Applicant that the claimed subject matter is not shown in the cited reference.

The section originally cited in Morris et al. by the Examiner, (col. 6, lines 34-51), discloses the use of an acoustic signal to be played by a speaker output device. The Examiner considers this to be equivalent to "producing an output signal". Since this is a sub-procedure within an overall process, the Examiner considers the output signal to be produced in a "method step".

The main point of contention seems to be whether or not the output signal is output only after checking whether an output mode is switched on. The Examiner believes that the cited section of the reference reads on the broadest reasonable interpretation of this limitation in at least two ways.

Firstly, the reference uses the language "if client computer A active sound buffer stores a first (and later in the cited section, a second) message packet...then client computer A enhancement routines can examine the source addresses of the message packets". The cited section then continues to disclose that these routines attach

pointer data to the first and second packets indicating that the acoustic signal is to be played on respectively left and right sides of the client computer A.

It is the Examiner's understanding with respect to this method that the acoustic (or output) signal will only be output to client computer A if the enhancement routines are in effect, and this requires message packets initially to be stored in the active sound buffers. This implies that the enhancement routines or some component(s) controlling the enhancement routines have to effectively check whether or not the sound buffers store message packets in order for the output signal to eventually be output. Since these buffers are concerned with a particular functioning arrangement or condition related to the eventual output of the acoustic signal and since they are capable of either resulting in the output of the signal or lack of output of the signal, contingent on the criteria that a packet must first occupy the buffer for a signal to eventually be output (with a lack of packet occupation resulting in no output signal), the Examiner considers the existence of a packet in the buffer to be equivalent to an output mode that is switched on.

Secondly, the Examiner recognizes the specific use of buffers for storing message packets in the method of Morris et al., which may eventually possibly result in the output of the output signal. The Examiner believes that whether by definition or by understanding to one of ordinary skill in the art, the type of buffer disclosed would be intended to function in a temporary intermediate storage state. Therefore the Examiner believes that the reference also implies that some form of a mode is checked as to whether or not it is switched on or off (in order to determine when the packet is to no



longer be stored in the buffer) as would be generally related to the use of a buffer storing message packets.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Gutierrez whose telephone number is (703) 305-1973. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on (703) 308-1677. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

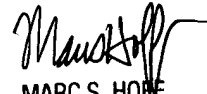
Art Unit: 2857

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0976.



Anthony Gutierrez

10/29/04



MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800